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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,495	07/25/2003	Troy Fields	20.2771	1494
23718	7590	10/05/2005	EXAMINER	
SCHLUMBERGER OILFIELD SERVICES 200 GILLINGHAM LANE MD 200-9 SUGAR LAND, TX 77478			COLLINS, GIOVANNA M	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HL

Office Action Summary

Application No.

10/604,495

Applicant(s)

FIELDS, TROY

Examiner

Giovanna M. Collins

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 2-16, 22, 36-47, 50, 51 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 17-21, 23-35, 48, 49, 52, 53, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20050713, 20050712</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 23-28,34,48,49,52,53,55,56 are rejected under 35 U.S.C. 102(e) as being anticipated by Bond 6,772,839.

Referring to claims 23, 52 and 53, Bond discloses a method of reducing debris in a perforation in a wellbore, comprising positioning a downhole tool in the wellbore the tool having a bit (90) extendable therefrom positioning the bit in the perforation to block debris (col. 7, lines 1-8).

Referring to claim 24, Bond discloses creating a perforation in a sidewall of the wellbore (fig. 13).

Referring to claim 25, Bond discloses detecting the debris (col. 1, lines 21-22).

Referring to claims 26 -27, Bond discloses activating the bit to dislodge debris from the perforations by advancing the bit (col. 7, lines 1-8).

Referring to claim 28, Bond discloses plugging the perforation (fig. 18).

Referring to claim, 34, Bond discloses the wellbore (16) is a cased wellbore.

Referring to claims 48-49 and 55-56, Bond disclose testing or sampling the formation fluid via the perforation (col. 1, lines 15-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by MacDougall et al. 5,692,565 in view of Bond '839.

Referring to claims 1 and 18-20, MacDougall discloses (figs. 1) a downhole tool for reducing debris comprising a housing (17) positionable in the cased wellbore (at 11), and an arm (18) in the housing and extendable therefrom and at least one debris blocker comprising a bit (19) adapted to create the perforation, the debris blocker positioned in the perforation via the arm and a seal (17b) and adapted to prevent debris from flowing through the perforation into the housing with a formation fluid whereby the contamination in the formation fluid is reduced. MacDougall does not disclose the debris blocker is releasable. Bond teaches a debris blocker that is releasable in order to plug a perforation. As it would be advantageous to plug the perforation when no longer needed it would be obvious to one of ordinary skill in the art at the time of the invention to modify the debris blocker disclosed by MacDougall to be releasable as taught by Bond.

Referring to claim 21, MacDougall discloses the bit is positionable in the perforation and is operable with a stationary (before retracting bit) and activated mode (fig. 5), wherein the station mode the bit permits the flow of fluid past the outer surface of the bit wherein preventing the flow of debris and in the activated mode the bit is movable to dislodge debris in the perforation.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall et al. 5,692,565 in view of Bond '839 as applied to claim 1 and further in view of Brieger 3,934,468.

MacDougall, as modified, discloses the tool of claim 1 but does not disclose the wellbore is uncased. Brieger teaches that it is well known in the art to also test uncased wellbores (col. 1, lines 1-26). As one of ordinary skill in the art would be familiar with also having a tool to get samples from uncased well bore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the tool disclosed by MacDougall to test uncased wellbore as taught by Brieger.

4. Claims 29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bond '839 in view of Urbanosky 3,924,463.

Bond discloses the method of claim but does not disclose a filter. Urbanosky teaches a filter to further filter smaller particles of plugging materials (col. 4, lines 50-56). As it would be advantageous to filter as much of the debris as possible, it would be

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obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Bond to have a filter as taught by Urbanosky.

Referring to claims 31 and 32, Urbanosky teaches filters (45 and 46) that are stacked concentrically.

5. Claims 29-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bond '839 in view of Taggart 3,430,711.

Bond discloses the method of claim 23 but does not disclose a filter. Taggart teaches a filter to further filter smaller particles of plugging materials in the formation fluid (col. 3, lines 10-16). As it would be advantageous to filter as much of the debris as possible, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Bond to have a filter as taught by Taggart.

Referring to claim 30, Bond does not disclose advancing the bit through the filter. However, Bond discloses permanently plugging the perforation with the bit when testing is complete (col. 12, lines 58-67). As it would be advantageous to fully plug the perforation when the testing period is complete, it would be obvious to one of ordinary skill in the art to modify the bit disclosed by Bond to advance through the filter.

Referring to claims 31 and 33, Bond as modified does not disclose stacking more than one filter linearly in the perforation. However, duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to further modify the method disclosed

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by Bond stack more than more filter linearly because duplicating the components of a prior art device is a design consideration within the skill of the art.

6. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bond '839 in view of Brieger 3,934,468.

Bond discloses the method of claim 23 but does not disclose the wellbore is uncased. Brieger teaches that it is well known in the art to also test uncased wellbores (col. 1, lines 1-26). As one of ordinary skill in the art would be familiar with also having a tool to get samples from uncased well bore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Bond to test uncased wellbore as taught by Brieger.

Response to Arguments

Applicant's arguments filed 7/13/05 have been fully considered but they are not persuasive. Referring to the arguments concerning the Bond reference, the debris blocker (90) disclosed by Bond will block some debris that is too big to fit past the helical grooves or holes provided in the bit.

Applicant's arguments with respect to claims 1 and 17-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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